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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,721	11/12/2003	Gregory B. Altshuler	105090-207	7252
21125 7590 12/23/2008 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER SHAY, DAVID M	
			ART UNIT 3769	PAPER NUMBER
			NOTIFICATION DATE 12/23/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,721	<b>Applicant(s)</b> ALTSHULER, GREGORY B.	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on September 26, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-20,23-25,27-38 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-20,23-25,27-38 and 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>August 15, 2008 and October 27, 2008</u> .                    | 6) <input type="checkbox"/> Other: _____                          |



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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2008 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The drawings are objected to because in Figure 1, elements 112 and 113 are not designated by indicia indicative of their function; in Figure 2, elements 212, 213, and 215 are not designated by indicia indicative of their function; in Figure 3, elements 311c, 312, and 313 are not designated by indicia indicative of their function; in Figure 4, elements 411d, 411d', 412, and 413 are not designated by indicia indicative of their function; in Figure 5, elements 527, 528, and 563 are not designated by indicia indicative of their function; in Figure 6, element 601 is not designated by indicia indicative of its function; in Figure 7, elements 701, 703, 704, 705, 706, and 709 are not designated by indicia indicative of their function; in Figure 8, elements 825, 826, and 827 are not designated by indicia indicative of their function; in Figure 9, elements 926A, 927, 930, 931, 933, and 936 are not designated by indicia indicative of their function; in Figure 10, elements 1027, 1028, 1030, 1031, 1043, 1044, 1045, and 1046 are not designated by indicia indicative of their function; in Figure 11, elements 1128, 1131, 1143, 1145, 1156, and 1157 are not designated by indicia indicative of their function; in Figure 12, elements 1258, 1259, and 1260 are not designated by indicia indicative of their function; in Figure 13, elements 1302, 1303, 1304, 1305, 1306, 1307, 1308, 1309, 1310, 1312, 1314, 1318, 1320, 1324, and 1326 are

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not designated by indicia indicative of their function; in Figure 14, elements 1402, 1304, 1406, 1408, and 1410 are not designated by indicia indicative of their function. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “controls for selecting and sequentially operating said sources in a selected sequence to form a time-varying irradiation pattern” and “interlock which operates in conjunction with said controls to disable operation of said sources unless said component is properly positioned to protect said selected portion”; the “diagnostic tool mounted on said mount...wherein the treatment region is the subject’s face...” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant argues that the interlock limitation discussed in the drawing objections is shown in amended Figure 8 which was amended to show “the interlocks 813 as described in the specification at paragraph [0057]”. However, the originally filed disclosure discusses no element 813, nor is there any indication of any type of mechanism that can be interpreted as an interlock situated in the positions illustrated by elements 813 in the amended drawing. Thus this Figure is not approved as containing new matter.

The amendment filed December 18, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

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supported by the original disclosure is as follows: the location and function of the interlocks 813 as shown in the amended drawing Figure 8. “The sapphire window...is held near room temperature by small thermo-electric modules mounted on either side of the diode bars”.

Claims 1, 2, 4-7, 9-20, 24, 25, 27, 28, 30, 31, 35-38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell in combination with Altshuler ('813) and Anderson et al (US 20020161357). Russell teaches a device as claimed except for the diagnostic sensor. Altshuler ('813) teaches the desirability of the use of a diagnostic sensor and a gel. Anderson et al (US 20020161357) teach the desirability of turning off the sources i a selected sequence to provide q time varying irradiation pattern. It would have been obvious to the artisan of ordinary skill to employ the diagnostic sensor of Altshuler ('813) in the device of Russell, since this would control application of the energy to prevent damage to the skin; to employ the gel, since this provides index matching, and to employ a switching array formed of separate switches, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides a predictable result, and to employ a control to produce a time-varying pattern, since this can prevent thermal injury, as taught by Anderson et al (US 20020161357), and to configure the sources as U-shaped lamps, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and would provide a larger irradiating area, thus producing a device such as claimed.

Claims 1, 2, 4-7, 9-20, 24, 25, 27, 28, 30, 31, 35-38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in combination with Altshuler ('813) and Anderson et al (US 20020161357). Alexander et al teach a device as claimed except for the sensors that prevent the operation of the sources if the device is not properly positioned.

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Altshuler ('813) teaches the desirability of the use of a diagnostic sensor. Anderson et al (US 20020161357) teach the desirability of turning off the sources in a selected sequence to provide a time varying irradiation pattern. It would have been obvious to the artisan of ordinary skill to employ the diagnostic sensor of Altshuler ('813) in the device of Alexander et al, since this would control application the energy to prevent damage to the skin and to employ the gel, since this provides index matching, and to employ a switching array formed of separate switches, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides a predictable result, and to employ a control to produce a time-varying pattern, since this can prevent thermal injury, as taught by Anderson et al (US 20020161357), and to configure the sources as U-shaped lamps, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result; and would provide a larger irradiating area, thus producing a device such as claimed.

Claims 8, 23, 29, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Russell or Alexander et al in combination with Altshuler ('813) and Anderson et al (US 20020161357), as applied to claims 1, 2, 4-7, 9-20, 24, 25, 27, 28, 30, 31, 35-38, and 40-44, and further in combination with Eckhardt et al. Eckhardt et al teach an irradiation device with sensors that do not allow the device to be actuated unless the device is properly positioned. It would have been obvious to the artisan or ordinary skill to employ the sensors of Eckhardt et al in the apparatus and method of Russell or Alexander et al, since Russell or Alexander et al discuss the need for protecting certain areas of the body from exposure, thus producing a device and method such as claimed.

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Claims 32, 33, and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Russell or Alexander et al in combination with Altshuler ('813) and Anderson et al (US 20020161357), as applied to claims 1, 2, 4-7, 9-20, 24, 25, 27, 28, 30, 31, 35-38, and 40-44, and further in combination with Altshuler et al. Altshuler et al teach an irradiation device with diagnostic sensors that do not allow the device to be actuated unless the device is properly positioned. It would have been obvious to the artisan or ordinary skill to employ the sensors of Altshuler et al in the apparatus and method of Russell or Alexander et al, since this prevents undesired damage to the skin, as taught by Altshuler et al, and in either case to employ a wireless connection, since this is not critical; is well within the skill of one having ordinary skill in the art; would enable the illuminator to be used without tethering the user to the controller, thereby providing greater mobility, official notice of which is hereby taken; and provides no unexpected result, and to employ a gel to enhance the transmission of light into the skin, since this is not critical; is well within the skill of one having ordinary skill in the art; provides no unexpected result and would provide cooling, thus producing a device and method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-20, 23-25, 27-38, and 40-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 7,309,335. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-20, 23-25, 27-38, and 40-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 20-31 of U.S. Patent No. 7,309,335 in view of Anderson et al (US 20020161357). Anderson et al (US 20020161357) teach the desirability of turning off the sources in a selected sequence to provide a time varying irradiation pattern. It would have been obvious to the artisan of ordinary skill to employ a control to produce a time-varying pattern, since this can prevent thermal injury, as taught by Anderson et al (US 20020161357), thus producing a device such as claimed.

Applicant's arguments with respect to claims 1-20, 23-25, 27-38, and 40-47 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769